

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 96-060-C1	
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		First Named Inventor Jay S. Walker	
		Art Unit 3692	Examiner Clement B. Graham

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

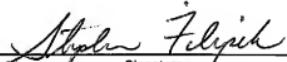
I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.
Registration number 33,384

attorney or agent acting under 37 CFR 1.34.
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Signature

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May 30, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

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PRE-APPEAL REQUEST FOR REVIEW

Applicants respectfully request Pre-Appeal Review of the rejections set forth in the Final Office Action mailed December 31, 2007 (the "Final Action"). No amendments are being filed with this Request, and this Request is being filed concurrently with a Notice of Appeal.

REMARKS

I. Introduction

Claims **79-101** are pending, and claims **79, 83, 87, 91, 95 and 99** are the only independent claims.

The undersigned attorney telephoned the Examiner on May 1, 2008 in an attempt to better understand and perhaps resolve at least some of the rejections, but the Examiner refused to conduct an interview. The undersigned did ask some questions, but the Examiner could not provide a rationale for the Section 101 rejections, and several other requests for clarification also went unanswered. Applicants therefore felt compelled to file this Pre-Appeal Request.

Review is requested for the reasons recited below. Please note that, in the arguments, claim limitations are indicated by *italics*.

II. The Claim Rejections

Claims **83-85, 91-95 and 99-100** stand rejected for allegedly being directed to non-statutory subject matter under Section 101. Claims **79 and 83** stand rejected for allegedly being indefinite under Section 112, second paragraph. Lastly, claims **79-101** stand rejected for allegedly being unpatentable over Berger, U.S. Patent No. 5,477,037 (hereinafter "Berger") in view of Ginter, U.S. Patent No. 6,658,568 (hereinafter "Ginter") under Section 103(a).

III. Claims 83-86, 91-94 and 99-101 Are Computer Readable Medium Claims and Are Drawn to Patentable Subject Matter

Applicants respectfully submit that the Examiner has misread claims **83-85, 91-95 and 99-100**, and thus is mistaken when he states:

"Claims 83-85, 91-95, 99-100 are rejected under 35 U.S.C. 101 because... Applicant's claims are directed to an algorithm. Specifically, claims 82-85, 91-95, 99-100 recites 'associating', 'receiving'... however these steps are mere ideas in the abstract... that do not apply, involve, for example, and (sic., "are") abstract ideas without a practical application (sic., "and") are found to be non-statutory subject matter. Therefore, Applicant's claims are non-statutory as they do not produce a useful, concrete and tangible result." (Final Action, page 2, item 2)

First, each of the rejected claims recite a computer readable medium storing instructions configured to direct a processor to perform the functions listed, and thus are *not* directed to an algorithm. Second, each of these claims *is* statutory, because the claimed computer-readable medium are encoded with instructions that define structural and functional interrelationships between the instructions and the processor which permit the instruction's functionality to be realized. Such claims are indeed statutory (See MPEP 2106.01 which cites *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)). Third, each of these claims produces a useful and concrete result, at least because they recite instructions that cause a processor to charge a credit card account (claims **83 and 91**), or that cause a processor to print a payment draft, transmit a serial number and receive a verification code (claim **99**).

In addition, the Examiner appears to have mistakenly included method claims **82 and 95** in this rejection. This may be a typographical error in the Final Action, because claim **82** depends upon claim **79** and adds the steps of *determining if the user is found in a membership database, and prompting the user to register a copy of payment draft software if the user is not found in the membership database*, which is a useful, concrete and tangible result. Similarly, independent claim **95** includes the steps of *printing the payment draft, and receiving a verification code from the issuer central controller*, which are useful, concrete and tangible results. Thus, claims **82 and 95** recite statutory subject matter.

In view of the above remarks, we respectfully submit that each of claims **82-85, 91-95 and 99-100** recites statutory subject matter, and thus that this Section 101 rejection cannot stand.

IV. Claims 79 and 83 Particularly Point Out and Distinctly Claim the Invention

The PTO's policy manual (See MPEP 2173.02) provides that the Examiner, in reviewing a claim for compliance with Section 112, second paragraph, must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the required notice function, by providing clear warning to others as to what constitutes infringement of the patent (citing, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000); ... and *Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1366, 71 USPQ2d 1081, 1089 (Fed. Cir. 2004) ("The requirement to 'distinctly' claim means that the claim must have a meaning discernible to one of ordinary skill in the art when construed according to correct principles....Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at

construction must a court declare it indefinite."). Accordingly, a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible. Furthermore, even if it is a formidable task to understand a claim, and the result is not unanimously accepted, as long as the boundaries of a claim may be understood it is "sufficiently clear to avoid invalidity [for] indefiniteness." See *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1383 (Fed. Cir. 2005).

Appellants respectfully submit that independent claims **79 and 83** are not insolubly ambiguous. The Examiner isolated the phrase: *associating in a database a credit card account number and a serial number of a payment draft*; as being unclear for the following reason:

"...how can one associate in a database a credit card account number and a serial number of a payment draft with out storing the information first?????..." (Final Action, page 2).

But Applicants are not aware of any statute or practice rule requiring claims to specifically recite populating a database with information before reciting a function that associates data in a database. Furthermore, the process of associating data in a database is supported in the present specification, for example, by Figs. 3A to 3C and page 12, line 5 to page 14, line 13. Thus, such a rejection is without merit because one skilled in the art would easily understand how a credit card account number would be associated in a database with a serial number of a payment draft. Applicants therefore respectfully assert that claims **79 and 83** are not indefinite, and that this Section 112, second paragraph rejection cannot stand.

V. Claims 79-101 Are Patentably Distinct Over Berger and Ginter

(a) Claims 79-94

Applicants respectfully submit that Berger does not suggest or teach *associating in a database a credit card account number and a serial number of a payment draft*, as required by independent claims **79 and 83**, nor *receiving from a user information including the credit card account number, the serial number of the payment draft, and a face value* as required by independent claims **79, 83, 87 and 90**. Rather, Berger pertains to a financial document dispensing apparatus for check drafts and charge receipts that can be used in remote locations, and that uses blank forms preferably provided in a continuous fan-fold stack. (See Berger, col. 3, lines 20-35).

The Examiner cites Berger at col. 4, line 41 to col. 5, line 3 and col. 5, lines 14-40 as allegedly disclosing the elements of the pending claims highlighted above (Final Action, page 3).

But the cited portion of Berger merely describes the components of the check dispensing machine of Fig. 1, and discloses that a user enters data including account identification and a requested check amount. After identity and account verification by a financial institution, the printer unit prints the request check amount on to a blank check form stored within the printer unit and dispenses. At the end of the business day, the printer unit prints a transaction summary onto one or more blank check forms (col. 4, lines 40-56). Nowhere does Berger teach or suggest that any of the "transaction data" supplied by the user includes a serial number, much less teach or suggest associating a credit card account number and a payment draft serial number in a database. Thus, Applicants strongly disagree with the Examiner's contention that Berger somehow "inherently" teaches such processes (see Final Action, page 3).

Furthermore, the Examiner admits that Berger does not teach or suggest *receiving an indication from a third party of the serial number and the face value of the payment draft* as recited by claims 79, 83, 87 and 91. Ginter was cited for allegedly teaching third parties "to verify transactions" (Final Action, pages 3-4). But Ginter pertains to an infrastructure support system for secure commerce transactions, and the cited portion (col. 104, line 48 to col. 105, line 13) only describes an "usage clearinghouse" for providing data to other electronic commerce support services. Ginter does not specifically teach receiving an indication of the serial number and face value from a third party in the same context of the pending claims. Moreover, Ginter does *not* cure the deficiencies of Berger outlined above. In particular, Ginter does not suggest or teach *receiving from a user information including the credit account number, the serial number of the payment draft and the face value*. Instead, Ginter is focused on the usage clearinghouse, which may provide services such as providing data and/or reports to third parties. Thus, neither Berger nor Ginter, alone or in combination, teaches or suggests at least the elements highlighted above that are recited by independent claims 79, 83, 87 and 91.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness, and thus the rejection of claims 79, 83, 87 and 91 under Section 103(a) cannot stand. The rejections of dependent claims 80-82, 84-86, 88-90 and 92-94 should also be withdrawn for at least the same reasons.

(b) Claims 95-101

Independent claims 95 and 99 concern a process for a user to obtain a payment draft and to register it with a central controller. Claim 95 is illustrative, and includes:

printing the payment draft, the printed payment draft including the face amount and a serial number;
transmitting the serial number to the issuer central controller for registration; and
receiving a verification code from the issue central controller.

Neither Berger nor Ginter teaches or suggests such operation. In particular, the Examiner cited the same portions of Berger and Ginter (Final Action, pages 8-9) discussed above, but failed to provide any rationale whatsoever as to how these references teach the elements highlighted above. Applicants note that, with regard to claim 95, the Examiner states “Berger fail (sic, “fails”) to explicitly teach third party.” (See page 9 of the Final Action). But claim 95 does **not** include any verbiage concerning a “third party”. Thus, it appears that the Examiner failed to grasp the scope of claim 95, and therefore cannot have established a *prima facie* case of obviousness. The same “back of the hand” treatment was accorded claim 99, which also does **not** recite any language with regard to third parties. Accordingly, the Examiner has not established a *prima facie* case of obviousness for claim 99 either. Consequently, the Section 103(a) rejections of independent claims 95 and 99 cannot stand. Furthermore, the rejections of dependent claims 96-98 and 100-101 should also be withdrawn for at least the same reasons.

In view of the above remarks, Applicants respectfully request withdrawal of all of the Section 103(a) rejections.

VI. Conclusion

Applicants respectfully request review and reversal of all of the rejections of the pending claims.

Respectfully submitted,

May 30, 2008
Date

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